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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
05/876,179	06/13/97	LEE	B P54596

ROBERT E BUSHNELL
SUITE 425
1511 K STREET NW
WASHINGTON DC 20005-1401

MM11/0105

EXAMINER

GUSHI, R

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 01/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/876,179

Applicant(s)
Lee

Examiner
Gushi, Ross

Group Art Unit
2833



☒ Responsive to communication(s) filed on Oct 22, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) 9 is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-8 and 10-18 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2833

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 through 18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 6, and 12 each recite a “printed circuit board bearing a bore.” A “bore” is not mentioned, disclosed, or defined in the application as filed, nor shown in the figures of the application as originally filed. The remaining dependent claims are rejected for being dependent on the rejected independent claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2833

4. Claims 1 through 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the words of the applicant:

As amended, Claim 1 makes it clear that there is a first connector that comprises both a first connector and a second connector and that there is a second connector that comprises both a plurality of contacts and a plurality of terminals. Newly amended Claim 1 also specifies that the second connector automatically engages when the first connector is engaged. Remarks, page 10.

In claims 1 through 18, either there are two or more different sets of mating parts which the applicant has failed to distinguish from each other or there is one set of mating parts which the applicant appears to be claiming twice or more. Thus the claims are vague and ambiguous. Similarly, in claim 1, the applicant claims: "a disk assembly comprising: . . . a printed circuit board attached to said body . . . ; and a plurality of contacts mounted on said printed circuit board; . . . a printed circuit board assembly, comprising . . . a second connector engageable . . . while said printed circuit board assembly is attached . . . ; and a plurality of contact connectors, comprising: said circuit board assembly" Again, either there are two or more printed circuit boards which are not distinguished in the claims, or there is a single circuit board which is claimed multiple times in the same claim. Independent claims 6 and 12, although worded slightly differently, have the same ambiguities. The remaining dependent claims fail on the grounds that the respective independent claims fail. Furthermore, claims 3 and 8 refer back the

Art Unit: 2833

“said printed circuit board,” however this limitation has multiple antecedent bases, and thus is vague and ambiguous.

5. In addition to the foregoing, claims 3 and 8 are indefinite in that they claim a “printed circuit board on said disk assembly being flexible.” The dangling modifier describes a flexible disk assembly, however, it is probably not the disk assembly which is flexible. If it is the applicant’s intent to claim a flexible disk assembly, then claims 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, for containing subject matter not disclosed in the original application as filed.

Claim Rejections - 35 USC § 102

6. As well as can be determined, the ***35 USC § 102*** rejections as stated in the first office action are still applicable. Thus, claims 1, 6, and 12 are rejected under Takagi and/or Morehouse for the reasons given in the first office action.

Claim Rejections - 35 USC § 103

7. As well as can be determined, the ***35 USC § 103*** rejections as stated in the first office action are still applicable. In addition to the reasons given in the first office action, claims 2, 4, 5, 7, 10, 11, 13, 14, 15, and 16 as amended are rejected under 35 U.S.C. 103(a) as being

Art Unit: 2833

unpatentable over Morehouse, et al in view of Kaufman, as discussed in the first office action. In claims 2, 4, 5, 7, 10, 11, 13, 14, 15, and 16, the applicant claims the terminals as being elastic, C-shaped, P-shaped, hook shaped, or V-shaped. The terminals as taught Kaufman are inherently elastic, since they are described as a "J-shaped spring portion." Kaufman at col 2, lines 18 through 20. Furthermore, it would have been obvious to one with ordinary skill in the art that the terminals being described as "J-shaped" in Kaufman could as well be described as "C-shaped," "hook shaped," "P-shaped," or "V-shaped" or be configured in these shapes without altering the functionality of the terminals.

Applicant's arguments with respect to claims 1-8 and 10-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2833

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross N. Gushi whose telephone number is (703) 306-4508.



Hien Vu
Primary Examiner

rng

December 29, 1998

Application/Control Number: 08/876179

Page 7

Art Unit: 2833